



PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 1733**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yuichiro OGAWA

Group Art Unit: 1733

Application No.: 09/370,981

Examiner: J. Fischer

Filed: August 10, 1999

Docket No.: 104018

For: PNEUMATIC RADIAL TIRES

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 10, 2003 Office Action, the period for reply effectively extended by the attached Petition for Extension of Time to March 22, 2004, reconsideration of the above-identified application is respectfully requested. Claims 1, 2, 4 and 6-10 are pending with claims 6-8 and 10 withdrawn from consideration.

Entry of the Request is proper under 37 CFR §1.116 since the Request: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issues requiring further search and/or consideration; (c) does not add any additional claims; and (d) places the application in better form for appeal, should an appeal be necessary. Entry of the Request is thus respectfully requested.

An Election of Species Requirement was required between the figures. Accordingly, Applicant elected Species I, Figs. 1, 3, 4 and 5 and Species A, Fig. 2, claims 1-4 and 9.

However, Applicant continues to retain claims 6-8 as they are dependent from claim 1 and remain generic to claim 1. Thus, claims 6-8 would be allowable for the same reasons claim 1 is allowable.

Furthermore, Applicant also requests consideration of claim 10 because Applicant asserts that a search for claim 10 does not place a serious burden upon the Examiner. In accordance with MPEP S803, "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added).

In the instant application, the Examiner has only asserted that the claims are directed to distinct or independent inventions. The Examiner has not provided an explanation as to why it would be a serious burden to examine both claims 1 and 10.

In particular, Applicant's claim 10 recites a core which extends from an outside of the tire toward an inside thereof. Conversely, Applicant's claim 1 recites a core which extends from an inside of the tire to an outside thereof. As such, both claims are directed to distinct inventions based only on the direction in which the core extends.

However, the fact that claims are directed to distinct inventions alone is not sufficient to establish that a serious burden is being placed on the Examiner to examine both claims. In this regard, Applicant asserts that a serious burden is not being placed on the Examiner to review both claims. In Ueyoko, U. S. Patent No. 5,885,387, the Examiner applied a reference which uses a core which extends from both the inside of the tire toward the outside and from an outside of the tire toward the inside. Applicant also notes that the Examiner has also applied previous applied art which discloses similar features. Applicant thus asserts that a serious burden is not being placed on the Examiner to review both claims.

As previously stated, the Examiner believes that the depiction of both embodiments in a single reference is irrelevant. However, by stating that both embodiments are disclosed in a

single reference makes it evident that an unnecessary delay and expense to Applicant and duplicate examination by the U.S. Patent and Trademark Office exists because the search for the one embodiment overlaps the search for the second embodiment. It is thus respectfully requested that the Examiner explain why a serious burden is being placed on him to review the distinct claims when both embodiments are disclosed in previously applied art. It is also respectfully requested that claim 10 be entered and considered by the Examiner.

Claims 1, 2 and 9 were rejected under 35 U.S.C. §103(a) over JP 6-191238 (JP '238) in view of Ueyoko. The rejection is respectfully traversed.

Neither JP '238 nor Ueyoko disclose or suggest a pneumatic radial tire wherein the radial carcass is comprised of a rubberized ply of a continuous cord successively repeating round trip in at least one of the two bead cores as a pair between the pair of the bead portions along a circumference of the bead portion and a roundtrip return portion of the cord is existent in both the bead portions, in which the two bead cores in each of the bead portions are arranged adjacent to each other in a widthwise direction of the tire, and each of the two bead cores has such a rectangular structure that one or more steel wires are arranged lengthwise and widthwise in radial and widthwise directions of the tire, and the roundtrip return portion of the carcass ply cord is located through a side face of any one of the two bead cores so as to extend from an inside of the tire toward an outside thereof and cover at least a radially innermost steel wire arrangement of the respective bead core as recited in claim 1.

JP'238 discloses a pneumatic radial tire comprising a radial carcass 4 extending between a pair of bead portions 2 each including two bead cores 3A, 3B therein and reinforcing a pair of side wall portions and a tread portion. JP'238's two bead cores 3A, 3B in each of the bead portions 2 are arranged adjacent to each other in a widthwise direction of the tire, each of the two bead cores 3A, 3B has such a rectangular structure that one or more steel wires are arranged lengthwise and widthwise in radial and widthwise directions of the tire,

and an end of the carcass ply cord 41 is located through a side face of the two bead cores 3A, 3B so as to extend from an inside of the tire toward an outside thereof (3A is an inner layer bead core) and cover at least a radially innermost steel wire arrangement of the respective bead core.

However, JP'238 only describes a carcass 4 with a typical carcass arrangement containing cords arranged side by side in a circumferential direction. JP'238 thus suffers deficiencies as identified on page 1, lines 15-21 of Applicant's invention. It is neither taught nor disclosed in JP'238 to provide a continuous cord successively repeating roundtrip. As admitted, JP '238 is completely silent with respect to the use of a single, continuous cord (page 3 of the Office Action).

Ueyoko fails to overcome the deficiencies of JP '238 because Ueyoko only employs, as the upper bead cord 14, a continuous cord 15 that is substantially continuous to the carcass cord 10 (col. 5, lines 43-45). In using the phrase "substantially continuous", it means that the upper bead cord 14 and the carcass cord 10 are one continuous cord without interruption. As also shown in Figures 9 through 11 of Ueyoko, Ueyoko discloses two bead cores. However, the upper bead cord 14 and the carcass cord 10 remain continuous because it is only the lower bead cord 16 that may be formed as a non-continuous separate cord. (col. 6, lines 46-48). These two bead cores are also arranged adjacent to each other in the radial direction (up and down) of the tire.

Ueyoko also suffers the deficiencies of Applicant's related art as discussed on pages 2 and 3 of Applicant's specification. Applicant notes that Ueyoko corresponds to JP-A-9-155991. When the upper bead cord 14 and carcass cord 10 are made as one continuous cord, Ueyoko suffers deficiencies that Applicant's claim 1 overcomes with the radial carcass and bead cores that are made of different materials.

Applicant asserts that the combination of JP'238 and Ueyoko fails to render obvious the subject matter of claim 1. In rejecting claims under 35 U.S.C. 103, a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention must be provided. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

As admitted, JP'238 is completely silent with respect to the use of a single, continuous cord. JP'238 also suffers deficiencies as specifically identified by Applicant's specification. Although the use of a carcass structure to increase bead durability and contribute to the reduction of tire weight is desired, this advantage is neither taught nor suggested in JP'238 nor is there any disclosure or suggestion in JP'238 as to how this advantage can be obtained. Nor is there any motivation in JP'238 to look to Ueyoko to use a continuous cord. As such, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

To establish prima facie obviousness of a claimed invention, all the claim features must be suggested or taught by the prior art. It is also impermissible for an Examiner to engage in hindsight reconstruction of the claimed invention using Applicant's structure as a template and selecting elements from references to fill the page.

As specifically discussed, Ueyoko discloses an upper bead cord 14 and a carcass cord 10 that are continuous without interruption. Accordingly, in combining Ueyoko's endless carcass ply 11, whose formation is discussed in col. 5, lines 38-49, with JP'238, both the upper bead cord 14 and the carcass cord 10 would be transferred and added to JP'238's structure. Such that a combination is inappropriate and incorrect. Accordingly, Ueyoko's upper bead cord 14 and carcass cord 10 would have to be separated so that they are no longer

continuous. After separating the upper bead cord 14 and the carcass cord 10, the Examiner would then have to place Ueyoko's carcass cord 10 in JP'238. Alternatively, another method of forming an endless carcass ply, that is not disclosed by either JP'238 or Ueyoko, would have to be used. The separation of the upper bead cord 14 and carcass cord 10 is neither taught nor disclosed in Ueyoko nor is it disclosed or suggested in Ueyoko to form an upper bead cord 14 and carcass cord 10 separately. As such in order to obtain Applicant's claimed invention, impermissible hindsight reconstruction would have to be performed in order to 1) add Ueyoko's carcass ply 11 to JP'238 and to 2) modify Ueyoko's structure in order to add the carcass cord 10 alone to JP'238.

In view of the foregoing, the combination of JP '238 and Ueyoko fails to disclose or suggest all of the features of claim 1. In addition, claims 2 and 9 recite additional features of the invention and are also believed to be allowable at least for the reasons discussed above with respect to claim 1 and for the additional features recited therein. It is respectfully requested that the rejection be withdrawn.

Applicant appreciates the indication of allowability for claim 4. However, for the reasons discussed above, Applicant asserts that all of the claims are allowable.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: March 22, 2004

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